

REMARKS/ARGUMENTS

Applicant thanks the Examiner for the thorough consideration given the present application. Claims 1-6 and 8-13 are pending in the present application. In this Amendment, Applicant has canceled claim 3, and added the limitations of claim 3 to claims 1 and 12. The Examiner is respectfully requested to reconsider the final rejection of claims 1, 2, 4-6 and 8-13 and in view of the amendments and remarks as set forth herein below.

A. The Rejection of Claims 1, 8, 10-11 and 13 Under 35 U.S.C. §103

The Office Action has finally rejected claims 1, 8, 10-11 and 12 under the provisions of 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,552,989 (Bertrand) in view of U.S. Patent 4,661,811 (Gray et al.), and further in view of U.S. Patent 3,731,387 (Slemmons).

The Applicant respectfully submits that amended independent claims 1 and 12 and independent claims 8 and 13 are patentable over the cited prior art, because the independent claims all recite novel devices and methods for comparatively displaying dated map data from a navigation device. In amended independent claims 1 and 8, the dated map data is comparatively displayed using emphasized data items and normal data items. In independent claims 8 and 13, the dated map data is comparatively displayed using first and second display areas.

B. The Bertrand Patent

Bertrand, the primary reference relied upon in the Office Action, discloses a portable digital map reader which reads digital geographical maps recorded on magnetic or optical data and displays the geographical maps. The Examiner concedes that in the Bertrand patent there are several missing features including; (1) there is no disclosure of storing map data for a plurality of years; (2) there is no disclosure of editing the map data for different years and then superposing the map data for different years on a display; and (3) there is no disclosure of displaying the map data for different years in different display areas as claimed by the applicant. (See page 3 of the Office Action). It is respectfully submitted that none of these features is found in the other secondary references relied upon to reject the pending claims.

C. The Gray et al. Patent

The Gray et al. patent discloses a video map system in which map frames are stored on a video storage medium such as a video disk. A graphic generator stores overlay information such as the location of telephone lines, and the graphics generator then overlays an image of the telephone line information on the map. The Office Action points out that Gray et al. also overlays map information, but overlaying of map information as taught by Gray et al. actually teaches away from the claimed invention.

D. The Gray et al. Patent Teaches Away From The Claimed Invention

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983), and it is respectfully that Gray et al. patent teaches away from the claimed combination. The Office Action relies on Gray et al. as disclosing "wherein the edited map data from the specific year and the edited map data from the different year are superposed on the said displaying means (Gray '811: col. 9, Ins. 27-36)." See page 4 of the Office Action. It is respectfully submitted that the Gray '811 patent at col. 9, Ins. 27-36 at does not support the allegation in the Office Action, and actually teaches away from the claimed invention.

Contrary to the allegation in the Office Action, Gray et al. discloses a system having a video disk which does not include map data from different years. Instead, the old map information or affected area is "whited out" and new information is overlaid in the "white out" area. Gray et al. specifically discloses:

The use of a videodisc does suffer from the disadvantages that (at present) it is a read only device. Once having cut a master disc of the map background, ***it is not possible to modify the maps without producing a new disc.*** Where map changes are infrequent, this does not present a problem but in applications where up-to-date maps are an essential requirement, ***the difficulty can be overcome by vector digitising of the map changes (which can then be displayed by the overlay system) accompanied by a 'white out' of the affected map area from the videodisc frame.*** When sufficient changes to the map have taken place, a new disc can be produced at relatively low cost. [emphasis added]. See col. 3, lines 51-63.

Accordingly, while the video disk of Gray et al. may include “old” information and the overlay system may include “new” information, the displayed information never includes comparatively displayed dated map data as specifically recited in claim 1, 8, 12 and 13.

Gray et al. either displays the old map information from the video disk, or Gray et al. overlays updated or new information in a “white out” area corresponding to the old obsolete map information from the video disk. Gray’s overlaid map is effectively an updated map with the old information “whited out”. There is teaching whatsoever of displaying “edited map data from a specific year” and “edited map data from a different year” together as disclosed and claimed by Applicants. Accordingly, it is respectfully submitted that Gray cannot display map information of the type disclosed in Figs. 4-8 of the present application where the “old information” is not “whited out”, but instead it is retained and displayed together with “new information”. It also respectfully submitted that Gray et al. actually teaches away from the claimed invention.

E. The Slemmons Patent

The Slemmons patent discloses a method or an apparatus for plotting stock market data. At best, the Slemmons patent discloses a device for recording financial data from different days on a chart. Slemmons, like Bertrand and Gray et al., does not teach either storing, editing or displaying map data from a plurality of different years as claimed by the Applicant.

F. The Slemmons Patent Is Non-analogous Prior Art

Applicant respectfully submits that Slemmons' apparatus for charting stocks is not analogous prior art. A reference is analogous art if it satisfies one of two criteria: (1) it is from the same field of endeavor as that of the applicant, or (2) if not, it is reasonably pertinent to the particular problem with which the applicant was involved. *In re Clay*, 966 F.2d, 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). In the present case it is evident that Slemmons does not satisfy criterion (1), since it relates to the field of stock market charting, while appellant's field of endeavor is navigation systems. As for criterion (2), the Examiner asserts that Slemmnons is analogous because it is directed to the comparison data with respect to time.

However, the Applicant's claimed invention is not simply a comparison of numerical data to time. In the Applicant's claimed invention, there is a comparison of map features distributed within a two dimensional area, and a comparative display of how these map feature vary over time. In Slemmons, there is absolutely no disclosure of comparing map features or displaying a two dimensional area that varies over time. Thus, Slemmons is not pertinent to Applicant's particular problem, it is nonanalogous art, and it should not be used to reject the pending claims. *See also, In re GPAC Inc.*, 57 F.3d 1573, 1578 (Fed. Cir. 1995) (analogous art is a field of technology whose selection and adaptation would be suggested or motivated or taught, by sources in the prior art, as relevant to the problem facing this inventor).

G. The Slemmons Patent Does Not Provide The Necessary Motivation

It is respectfully submitted that one skilled in the art would not be motivated to combine the teachings of the Slemmons patent to the combination of Bertrand and Gray et al. There is simply no motivation to combine them as suggested in the Office Action. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself."). The teachings of Slemmons (col. 8, lines 45-55) relied upon in the Office Action state:

For the particular date (7-18-69), 2500 shares of the stock were traded. Accordingly, a line is made on charting sheet 14, using edge 58 as a guide, between the "0" and "25" scale graduations on the 0-50 volume scale 76. This new line indicates the present day's sale of 2500 shares, which sales immediately may be compared with the volume data 98 for the preceding days, which data also is visible through opening 50 of rule 36 before rule 36 is removed from the surface of charting sheet 14.

Slemmons discloses a chart containing financial data in which there are multiple days of data, and lines are drawn on a charting sheet using an edge 58 as a guide. There is no nexus or relationship between disclosed financial data and the claimed map data, and none of the techniques disclosed in Slemmnons would be useful for comparatively displaying map data. Accordingly, Applicant respectfully disagree that the teachings of Slemmons provide any motivation to modify the combination of Bertrand and Gray et al., and the only possible motivation is gleaned from the hindsight provided by the Applicant.

H. The Hypothetical Combination Is Not the Claimed Invention

The Office Action criticizes Applicant's argument that the hypothetical combination of the Bertrand patent in view of the Gray et al. patent and further in view of the Slemmons patent would not result in the applicant's claimed invention. More specifically, the Office Action states that the skilled artisan would not only overlay the telephone information on the map of Bertrand, but the skilled artisan would instead overlay new map information onto to the "affected area" or old map information. Even if the Office Action is correct, the hypothetical combination and resulting map would not be a "comparative display of map data from different years". Instead, the hypothetical combination would provide a current map in which the affected area or "old information" of Bertrand was "whited out" and overlaid with the "new information" of Gray et al. In effect, the updated information of Bertand and Gray et al. would be substantially identical to a new video disk of the type mentioned at col. 3, lines 61-63. ("When sufficient changes to the map have taken place, a new disc can be produced at relatively low cost.")

Even adding the teachings of Slemmons to the hypothetical combination of Bertrand and Gray et al. would not result in a "comparative display of map data from different years", because the "old information" and the "new information" would be melded together to form the equivalent of a new video disk. How can the "old information" be compared to the "new information" when Gray et al. instructs those skilled in the art to "white out" the affected map area? Again, even assuming the

Examiner's interpretation that Gray et al. would suggest the desirability of overlaying map information, it is respectfully submitted that the hypothetical combination of references would still not result in the Applicant's claimed novel display of comparative information.

I. The Amendments to Independent claims 1 and 12

Independent claims 1 and 12 have been amended to include the limitations of canceled dependent claim 3. It is respectfully submitted that the additions of the limitations of claim 3 to claims 1 and 12 do not raise new issues, and the entry of the amendments are earnestly requested. Moreover, U.S. Patent 6,107,961 (Takagi) that was cited against claim 3 does not use emphasized and normal items to *comparatively display dated map data* of the type claimed by the Applicant. Accordingly, the Applicant respectfully submits that amended independent claims 1 and 12 are further patentable over the cited prior art.

J. Dependent claims 2, 4-6 and 9-11

The Applicant believes that dependent claims 2, 4-6 and 9-11 are allowable over the prior art for at least the same reasons as the independent claims from which they depend.

K. Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard J. McGrath (Reg. No. 29,195) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By Michael K. Mutter, #29,680

MKM/RJM/kmr
1163-0369P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

(Rev. 02/12/2004)